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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/832,830	04/12/2001	Roberto Morlesin	Q63809	1936

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EXAMINER

LEON, EDWIN A

ART UNIT

PAPER NUMBER

2833

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/832,830

Applicant(s)

MORLESIN, ROBERTO

Examiner

Edwin A. León

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,8-12 and 17-21 is/are rejected.
- 7) ☒ Claim(s) 3-7, 13-16 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment filed September 17, 2002 in which Claims 2, 9 and 12 have been amended and new Claims 17-22 have been added, has been placed of record in the file as Paper No. 7.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 8-12 and 17-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Wolf (U.S. Patent No. 4,889,303). With regard to Claims 1, 9, 17-18 and 21, Wolf discloses a interconnection comprising a conductive core (formed by conductors 26) including a metal conductor (26) with, at each end thereof, an electrical connector (34,60), and a flexible tube (10) having at least an insulating layer (22) made of elastomeric material and covering the whole conductive core (formed by conductors 26). The method limitations are deemed inherent. See Figs. 1-2.

The recitation "a medium voltage" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951).

The limitation "for realizing an electrical connection between a receiving connector of a first equipment station and a receiving connector of a second equipment station" has not been given patentable weight since it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex. parte Masham*, 2 USPQ2d 1647 (1987).

The limitations "adapted to electrically connect a receiving connector of a first equipment station and a receiving connector of a second equipment station", and "adapted to mate the receiving connector" have not been given patentable weight since it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

With regard to Claims 2, 12 and 19-20, Wolf discloses the electrical connector (34,60) having a substantially conical shape of which a base (60) is connected to the metal conductor (26), the base (60) having a diameter relatively larger than the diameter of the metal conductor (26). See Figs. 1-2.

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With regard to Claim 8, Wolf discloses the flexible tube (10) having the same length as the conductive core (formed by conductors 26). See Figs. 1-2.

With regard to Claims 10-11, Wolf discloses the elastomeric material being a synthetic terpolymer of ethylene, propylene and diene [EPDM] or silicone. See Lines 50-51.

***Allowable Subject Matter***

4. Claims 3-7, 13-16 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The references fail to teach, disclose, or suggest, either alone or in combination, a conical bushing means made of insulating material and provided with the receiving connector so as to bring the electrical connector of the conductive core into contact with the receiving connector and the insulating layer of the flexible tube into contact with the inner side of the bushing means, the flexible tube having coaxially starting from the center: a first semiconductive layer, an insulating layer made of elastomeric material, and a second semiconductive layer, a ring groove in the first semiconductive layer, and a ring groove partially in the insulating layer, an external locking ring on at least one electrical connector of the conductive core, and at least one internal ring groove in the flexible tube for receiving the locking ring of the electrical connector when the tube is

released over the conductive core, and the flexible tube expanding and the conductive core including the first electrical connector relatively sliding inside the flexible tube.

### ***Response to Arguments***

5. Applicant's arguments filed September 17, 2002 have been fully considered but they are not persuasive. In response to Applicant's arguments regarding Claims 1 and 9 that the Wolf reference doesn't show a medium voltage interconnection, Applicant is reminded that the recitation "a medium voltage" has not been given patentable weight because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa V. Robie*, 88 USPQ 478 (CCPA 1951).

In response to Applicant's arguments regarding Claims 1 and 9 that the Wolf reference doesn't show the flexible tube being released over the conductive core, thus enabling the efficient manufacture of interconnections having different lengths without any significant additional costs, Applicant is reminded that the method limitations are deemed inherent since the Wolf reference (Column 4, Lines 8-16) describe that the tube (10) has a degree of flexibility to receive different sizes of conductive cores (26). Therefore, it would be inherent that the tube (10) has to be expanded and release to receive different cores (26).

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin A. León whose telephone number is (703) 308-6253. The examiner can normally be reached on Monday - Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula A. Bradley can be reached on (703) 308-2319. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
THO D. TA  
PRIMARY EXAMINER

Edwin A. Leon  
AU 2833

EAL  
November 20, 2002